

REMARKS

Upon entry of this Amendment, claims 1-71 will be pending, of which claims 1, 2, 3, 20, 30, 47, and 60 are independent. The claims have been amended, and new claims 3-71 have been added, to further specify Applicants' invention. Support for the amendments and new claims can be found throughout the application as filed and it is, accordingly, respectfully submitted that no new matter has been added. Reconsideration of the outstanding rejections and objections is respectfully requested in view of the above amendments and the following remarks.

Preliminarily, Applicants acknowledge the Examiner's remarks in paragraph 2 of the outstanding Office Action and intend to submit the original patent, or an affidavit/declaration as to the loss thereof, in due course.

With respect to the Examiner's comments regarding the written consent of the assignee to the filing of the Reissue application (paragraph 4 of the outstanding Office Action), Applicants note that such a written consent is being filed contemporaneously herewith.

Rejections under 35 U.S.C. §102 and/or 35 U.S.C. §103

Preliminarily, Applicants note that no art was cited against independent claims 1 and 2.

Regarding independent claim 3, Applicants note that this claim has been presented so as to incorporate the subject matter of previous claims 4-6. Previous claims 3-6, present claim 3, stand rejected over the prior art under 35 U.S.C. §102 and/or 35 U.S.C. §103. Applicants note, however, that none of the prior art rejections presented by the Examiner rejects all of previous claims 3-6. For instance, previous claims 3-5 stand rejected over EP 0,360,869 to Ohkawa *et al.*, but previous claim 6 does not stand rejected over this reference. *See* paragraph 39 of the outstanding Office Action. Similarly, previous claims 3 and 5-6 stand, for instance, rejected over U.S. Patent 4,656,090 to Markovitz, but claim 4 does not stand rejected over this reference. *See* paragraph 27 of the outstanding Office Action. Accordingly, Applicants respectfully submit that claim 3, is clearly distinguished over the art herein of record, and withdrawal of all the rejections of claim 3 under 35 U.S.C. §102 and 35 U.S.C. §103 is respectfully requested.

Regarding previous independent claim 26, newly presented as claim 20, Applicants note that this claim, as presented, incorporates the subject matter of previous claim 31. Applicants further note that no art was cited against previous claim 31. Accordingly, Applicants respectfully submit that instant independent claim 20 is clearly distinguished over the art herein of record, and withdrawal of all these rejections under 35 U.S.C. §102 and 35 U.S.C. §103 is respectfully requested.

Regarding previous independent claim 39, newly presented as claim 30, Applicants note that this claim has been presented so as to incorporate the subject matter of previous claims 46 and 47. Applicants further note that no art was cited against previous claims 46 and 47. Accordingly, Applicants respectfully submit that instant independent claim 30 is clearly distinguished over the art herein of record, and withdrawal of all the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 is respectfully requested.

Regarding independent claim 60, newly presented as claim 47, Applicants note that this claim has been presented to incorporate the subject matter of previous claim 77. Applicants further note that no art was cited against previous claim 77. Accordingly, Applicants respectfully submit that instant independent claim 47 is clearly distinguished over the art herein of record, and withdrawal of all the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 is respectfully requested.

Previous independent claim 80, newly presented as claim 60, stands rejected under 35 U.S.C. §102 as anticipated by or, in the alternative, under 35 U.S.C. §103 as obvious over EP 0,360,869 to Ohkawa *et al.* In paragraph 38 of the outstanding Office Action, the Examiner acknowledges that "Ohkawa et al. does not disclose the composition of claim 80". Applicants concur with this acknowledgement and, accordingly, respectfully request withdrawal of all the rejections of claim 80 under 35 U.S.C. §102 and 35 U.S.C. §103.

For at least the reasons presented above, Applicants respectfully submit that instant independent claims 1-3, 20, 30, 47, and 60 are patentable over the art herein of record. Accordingly, it is further submitted that all claims dependent thereon, *i.e.* all remaining pending claims, are also distinguished over the art herein of record. Consequently,

withdrawal of all the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 set forth in the outstanding Office Action is respectfully requested.

Rejections under 35 U.S.C. §112, first paragraph, and/or 35 U.S.C. §251

- re: Paragraphs 7-9, 11-12, 14-15, 17-18, and 22 of the outstanding Office Action.

Applicants have reviewed and revised the claims bearing in mind the Examiner's concerns expressed in paragraphs 7-9, 11-12, 14-15, 17-18, and 22 of the outstanding Office Action regarding 35 U.S.C. §112, first paragraph, and 35 U.S.C. §251. Withdrawal of the rejections set forth in these paragraphs is respectfully requested in view of the claim revisions.

- re: Paragraphs 10, 13, and 16 of the outstanding Office Action.

Regarding the rejection of previous claim 10, newly presented as claim 7, and previous claims 24, and 36 under 35 U.S.C. §112, first paragraph, and under 35 U.S.C. §251, Applicants note that these claims have been cancelled. Accordingly, it is respectfully submitted that these rejections are moot.

- re: Paragraph 19 of the outstanding Office Action.

Previous claim 83, newly presented as claim 63, stands rejected under 35 U.S.C. §112, first paragraph, and under 35 U.S.C. §251. Applicants note that the dependency of claim 63 has been changed from previous claim 80 to claim 61, and it is respectfully submitted that claim 63, as amended, is in full compliance 35 U.S.C. §112, first paragraph, and 35 U.S.C. §251.

- re: Paragraph 20 of the outstanding Office Action.

Previous claims 18 and 54 stand rejected under 35 U.S.C. §112, first paragraph, and under 35 U.S.C. §251. Applicants thank the Examiner for pointing out the clerical error regarding the weight ratio of cationically polymerizable components to radically polymerizable components. Previous claim 54 has been newly presented as claim 41 pursuant to the Examiner's remarks. Previous claim 18 is newly presented in claim 13, incorporating the features of previous claims 17 and 18.

- re: Paragraph 41 of the outstanding Office Action.

Previous claims 3-38, newly presented in claims 3-29, stand rejected under 35 U.S.C. §251. The Examiner contends that "[i]nstant claims 3-38 are all of the same or broader scope than the claims given up when applicants added water as an essential component in Paper No. 6 of parent application 08-476,482". See paragraph 41 of the outstanding Office Action.

Applicants disagree with the Examiner's contention but, in order to expedite prosecution, have revised independent claims 3 and 26, newly presented as claims 3 and 20, to include water as part of the claimed compositions. Accordingly, withdrawal of the 35 U.S.C. §251 rejection is respectfully requested.

Rejections under 35 U.S.C. §112, second paragraph

- re: Paragraph 21 of the outstanding Office Action.

Claims 1-2 stand rejected under 35 U.S.C. §112, second paragraph. Applicants have revised the claim language to further clarify the antecedent basis for each of the recited epoxy resins. It is respectfully submitted that claims 1-2, as amended, are in full compliance with 35 U.S.C. §112, second paragraph.

- re: Paragraph 28 of the outstanding Office Action.

Present claims 18, 30, 54, 71, and 80-83, newly presented in claims 23, 41, 52, and 60-63, stand rejected under 35 U.S.C. §112, second paragraph. Applicants have reviewed and revised the claims bearing in mind the Examiner's concerns and withdrawal of the rejections set forth in paragraph 28 of the outstanding Office Action is respectfully requested in view of these revisions.

- re: Paragraph 29 of the outstanding Office Action.

Previous claims 10-18, 20, 24, 26-38, 46-54, 56, 63-71, 73, and 80-83, newly presented as claims 7-13, 15, 20-29, 36-41, 43, 49-53, 60-63, stand rejected under 35 U.S.C. §112, second paragraph.

Specifically, the Examiner has rejected claims all of these claims (except new claim 15) by contending that the terms "mono-functional acrylate" and "trifunctional acrylate" are indefinite. *See* paragraph 29 of the outstanding Office Action. Applicants disagree with the Examiner's contention, and respectfully submit that these terms are adequately described in the specification. *See*, for instance, page 4, lines 36-39, of the specification. Nevertheless, in order to expedite prosecution, Applicants have substituted these terms with "mono-acrylate monomer" and "tri-acrylate monomer".

Applicants similarly disagree with the Examiner's contention that it is unclear what is meant with the functionality of the of the epoxy novolac resin in previous claims 20, 32, 56, and 73, newly presented as claims 15, 24, 43 and 54, and respectfully submit that one of ordinary skill in the art would understand "functionality" to refer to the average number of epoxy groups being present in the epoxy novolac molecules of the resin. However, in order to expedite prosecution, Applicants have revised the claim language pursuant to the Examiner's concerns.

With respect to the Examiner's concerns regarding previous claims 24 and 36, Applicants note that these claims are no longer before the Examiner and respectfully submit that the rejection of these claims is moot.

Withdrawal of all rejections set forth in paragraph 29 of the outstanding Office Action is respectfully requested.

- re: Paragraphs 30-31 of the outstanding Office Action.

Applicants have reviewed and revised the claims bearing in mind the Examiner's concerns and withdrawal of the rejections set forth in paragraphs 30 and 31 of the outstanding Office Action is respectfully requested in view of these revisions.

Rejections under 35 U.S.C. §101

Claim 81 stands rejected under 35 U.S.C. §101. *See* paragraph 23 of the outstanding Office Action. Applicants have reviewed and revised claim 81, newly presented as claim 61, bearing in mind the Examiner's concerns and withdrawal of the rejection is respectfully requested.

For any and all of the above reasons, it is respectfully submitted that the present invention is patentable.

CONCLUSION

Since all objections and rejections have been addressed and overcome, it is respectfully submitted that the instant Application is in condition for allowance and a Notice to that effect is earnestly solicited. If, after reviewing the above, the Examiner believes any issues remain unresolved, the Examiner is encouraged to contact the undersigned by telephone to expedite the prosecution of this application.

Respectfully submitted,
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